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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,436	06/25/2002	Mikio Watanabe	P22118	9261

7055 7590 07/21/2003

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9  
EXAMINER

HAMPTON HIGHTOWER, PATRICIA

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,436

Applicant(s)

WATANABE ET AL.

Examiner

Patricia Hightower

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/25/02;9/19/02;10/21/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Information Disclosure Statement***

The Information Disclosure Statements filed October 21, 2002 and September 19, 2002 have been considered and have been made of record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06 306264 A to Mitsui Toatsu Chem Inc. in view of Macromolecules, 21, 2, 1988, pg. 286, 293 taken w/JP-6 306264 A.

JP 06306264 A to Mitsui T. Chem inc. discloses a thermoplastic polymer composition composed mainly of a polylactic acid or a copolymer of lactic acid and other hydroxycarboxylic acid and contains a cyclic oligomer of lactic acid as a plasticizer. The process as instantly claimed for producing cyclic lactic acid oligomers by dehydrogenation condensation of lactide is conventional in the art. Although, the introduction of specific alkali metal compounds (i.e., Li, K, Na and Li preferred) such as those of the instantly claimed formula (2) into the reaction is not taught.

However, Macromolecules discloses the production of cyclic lactic acid oligomers from lactide in the presence of metal alkoxides.

JP 6-306264 A discloses n-butyl lithium, lithium phenoxide and the like as cyclic polycarbonate polymerization catalysts.

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Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made would have a reasonable expectation of success in the prediction of the kind of polymerization catalysts disclosed or taught by EP 0402676 could have been used as catalysts in the production of cyclic lactic acid oligomers as instantly claimed; thereby obtaining the instant invention as claimed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-306264.

JP 6-306264 discloses a cyclic lactic acid oligomer in claim 4 that anticipates the claimed cyclic lactic acid oligomer. See Claims; abstract.

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 21/21613 A1, Yanagisawa and Bhatia are cited to show the state of the art of the method of preparing cyclic lactic acid oligomers.

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Any inquiry concerning this communication should be directed to Patricia Hightower at telephone number (703) 308-2434. The examiner can normally be reached on M-F from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

P. Hightower/mn  
July 1, 2003



P. Hampton Hightower  
Primary Examiner  
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